

Atty. Dkt. No. EPI3007D  
(071344-0304)

### REMARKS

Claims 28, 31-38, 43, 50, 54-63 and 69-77 and 79 remain pending in this application since the last Amendment.

The remaining issues in the case are addressed below.

#### REJECTION FOR OBVIOUSNESS TYPE DOUBLE PATENTING

a) The rejection of claims 28, 31-38, 43, 50, 54-63, 69-77 and 79 being allegedly being obvious over claims 1-69 of U.S. Patent no. 6,417,429 is respectfully traversed. Applicants previously filed a terminal disclaimer for this patent in this case on March 15, 2004. A copy of the terminal disclaimer is attached as Exhibit A. Accordingly, the rejection is moot and should be withdrawn.

b) The rejection of claims 28, 31-38, 43, 50, 54-63, 69-77 and 79 being allegedly being obvious over claims 15-27, 29-65 and 83-92 of copending application serial no. 09/491,332 is respectfully traversed. The claims of the instant application are drawn to transgenic plant cells containing *inter alia* nucleic acid encoding immunoglobulin heavy and light chains, while the claims of the cited copending application are drawn to passive immunization with an immunoglobulin produced by plant cells. It is respectfully submitted that the Patent Office issued a restriction requirement distinguishing these two inventions (transgenic plants versus passive immunization) in parent application serial no. 08/642,406 on July 27, 1997. A copy of the restriction is attached as Exhibit B. Thus, it was the opinion of the Patent Office in the related earlier case that these inventions are patentably distinct. Accordingly, withdrawal of the instant provisional rejection is respectfully requested.

c) The rejection of claims 28, 31-38, 43, 50, 54-63, 69-77 and 79 being allegedly being obvious over claims 1-10 of copending application serial no. 10/372,614 is respectfully traversed. The claims of the instant application are drawn to transgenic plant cells containing *inter alia* nucleic acid encoding immunoglobulin heavy and light chains while the claims of the cited copending application are drawn to a method of producing a biologically functional heteromultimeric mammalian protein in a plant.

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Composition and methods of making are generally considered patentably distinct under Patent Office restriction practice. In any event, no terminal disclaimer is procedurally required in this case where the provisional rejection involves two pending applications and where the rejection is the sole remaining issue in the case. See MPEP 804 (I)(B) (page 800-19), ("If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent . . . "). Accordingly, for all of the above reasons, withdrawal of the instant provisional rejection is appropriate.

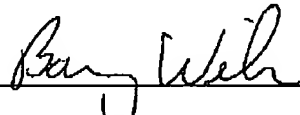
Because there are no issues that remain in the case, Applicants respectfully request the Examiner to issue a Notice of Allowance. The Examiner is urged to contact the undersigned by telephone to address is any other course of action is to be taken.

Respectfully submitted,

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